



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,906	01/22/2002	Hendrik Antonius Hoogland	294-106PCT/US	7316

7590

11/03/2006

Ronald J Baron
Hoffman & Baron
6900 Jericho Turnpike
Syosset, NY 11791

EXAMINER

JOHNSON, JERROLD D

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/913,906	Applicant(s) HOOGLAND ET AL.	
	Examiner Jerrold Johnson	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 and 39-41 is/are pending in the application.
- 4a) Of the above claim(s) 2-18, 29-31, 34-37 and 39-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 19-28, 32 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Butcher WO 98/19305 in view of Palmer et al. US 5,189,531 and Examiner Official Notice.

Butcher discloses the storage device and the method of manufacturing a storage device for plate shaped data carriers. On page 10, lines 37-31, Butcher describes how "an image can be embossed or raised out of the surface of the storage device through a single moulding operation." Butcher goes on to disclose that "Further, graphic images such as holograms can be added to the holder's surface. Hence information bearing holograms can be added for in-store tagging purposes."

Butcher does not explicitly disclose that a portion of the storage device is formed against or around the hologram, as is claimed. However, it could certainly be inferred through a reading of Butcher, that the hologram is integrally molded into the storage device, as that is the only process mentioned in this recitation. Again, Butcher describes just one method for adding images to the storage device, which is within the single injection molding operation. Butcher also does not specifically disclose that the hologram cannot be removed from the relevant part without damage, although a hologram provided in a single molding operation as taught by Butcher would likely

Art Unit: 3728

necessarily be damaged in this way, and therefor this limitation is inherently met by Butcher.

Finally, Butcher does not disclose that the information in the data carrier is incorporated into the hologram.

With respect to this limitation, limitations drawn to the content of indicia are properly treated as "printed matter" unless a new and unobvious functional relationship exists between the printed matter (the incorporation of product information into the protective means) and the substrate (the storage device).

In other words, it is only where there is a new and unobvious functional relationship between the printed matter and the substrate that the content of the printed matter is determined to be a structural limitation where the *particular* content of the indicia can be the basis of patentability.

In the determination of whether the printed matter is functionally related to the container, reference is made to the following two Federal Circuit decisions: *In re Gulack*, 703 F.2d. 1381 [217 USPQ 401] (Fed. Cir. 1983), and *In re Ngai* 70 USPQ 2d 1862 (CA FC 2004).

Quoting Gulack, "The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate." *Id.* at 1386. Accordingly, The CAFC determined that in Gulack there was a functional relationship between the printed matter and the substrate as the printed matter and the substrate were functionally interrelated.

Accordingly it was determined that there was a new and unobvious functional relationship between the substrate and the instructions.

To underscore this understanding, the CAFC stated within the *in re Ngai* decision "In Gulack, the printed matter would not achieve its educational purposes without the band, and the band without the printed matter would similarly be unable to produce the desired result." *Id.* at 1864.

In other words, the CAFC in Gulack sets forth what a new and unobvious functional relationship is with respect to this analysis, and this understanding was restated in Ngai.

In the present application, like the situation in *In re Ngai*, there is no new and unobvious functional relationship between the substrate (the storage device) and the printed matter (the product information in the protective means).

In Ngai, the court stated that "the printed matter in no way depends on the kit, and the kit does not depend on the printed matter." What was meant by this statement is that if the kit is suitable to perform its intended use without the printed matter, then there is no functional relationship as is understood in this analysis.

Similarly, in the present application, the storage device is suitable to perform the function of a storage device in the manner described in the specification irrespective of the specific product information in the protective means.

Accordingly, it is understood that a teaching of *any* indicia or information within the protective means of Butcher would suffice to reject these limitations. Butcher does

Art Unit: 3728

in fact suggest that the holograms are information bearing, and therefor meets this limitation.

Additionally, the claim limitation of "said protective means (the hologram) are designed such that specific product information is incorporated therein, specific for the data carrier to be stored in said storage device, so that an unequivocal relationship between the storage device and said data carrier is established" could be properly interpreted as the "intended use" of the information provided on the protective means.

For example, it is likely that the *intention* of the Visa credit card company that users of Visa credit cards will make an unequivocal relationship between 1) a protective device in the form of a hologram having a specific symbol (and eagle) that is disposed on Visa credit cards and 2) the Visa credit card company. However, regardless of this intent in the use of their credit card and the use of the protective device, the end user of the credit card may or may not make the association (the unequivocal relationship) that is intended by Visa. And in situations where the user does not comply with the *intent* of Visa in making this association (the unequivocal relationship), the Visa credit card (the "substrate" in the language of *In re Ngai*) will *still* function as it is intended as a credit card.

In the present application, the substrates (the storage device) will similarly perform its intended functions regardless of whether or not the end user makes an unequivocal relationship between the information in the hologram and information stored on the data carrier within the storage device.

And, with respect to an interpretation of these claim limitations within the context of "intended use" limitations, as is understood in the art, it is clear that whatever information Butcher intended be incorporated into his hologram, the information so incorporated into that hologram is inherently capable of being unequivocally related by the end user to the information on the data carrier.

To the extent necessary, Palmer et al. discloses the exact method step of forming a portion of a molded product against or around a protective means (hologram) in an injection molding step.

Accordingly, it would have been obvious to one of ordinary skill in the art to use the teachings of Palmer within the storage device of Butcher so as to minimize manufacturing steps.

Butcher also does not disclose the first and second cover pivotally connected and the fixing means. The Examiner takes Official Notice that this configuration of a storage device is the common configuration, and it would have been obvious to one of ordinary skill in the art to use the teachings of Butcher to the common configuration so as to maximize the commercial benefits of this concept. It is noted that Applicant did not contest this Official Notice.

Re the limitation in claim 1 drawn to the specific shape of the storage device, it is acknowledged that Butcher discloses a one piece storage device. However, one piece storage devices having first and second covers integral with each other are also well known. Again, the inventive concepts of Butcher are transferable to many known storage device configurations such as that of claims 1 and 20.

Claims 19-28, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butcher WO 98/19305 in view of Palmer et al. US 5,189,531 and Examiner Official Notice, and to the extent necessary, further in view of Sammet US 4,978,005 and Wood et al. 5,142,384.

Butcher discloses the storage device and the method of manufacturing a storage device for plate shaped data carriers. On page 10, lines 37-31, Butcher describes how "an image can be embossed or raised out of the surface of the storage device through a single moulding operation." Butcher goes on to disclose, "Further, graphic images such as holograms can be added to the holder's surface. Hence information bearing holograms can be added for in-store tagging purposes."

From this recitation, it can be inferred that Butcher contemplates two forms of information bearing images incorporated into the storage device, one being an image, the second being a hologram. Notice the use of the expression "Further." Butcher does not use the expression "Alternatively."

With respect to the first protective means set forth in claim 19, Butcher does not explicitly disclose that a portion of the storage device is formed against or around his graphic image (i.e. a printing) such as a hologram, as is claimed. However, it could certainly be inferred through a reading of Butcher, that the hologram is integrally molded into the storage device as that is the only process mentioned in this recitation. Again, Butcher describes just one method for adding images to the storage device, which is

within the single injection molding operation. Butcher also does not specifically disclose that the hologram cannot be removed from the relevant part without damage, although a hologram provided in a single molding operation as taught by Butcher would likely necessarily be damaged in this way. Finally, Butcher does not disclose that the information in the data carrier is incorporated into the hologram.

With respect to this limitation, limitations drawn to the content of indicia are properly treated as "printed matter" unless a new and unobvious functional relationship exists between the printed matter (the incorporation of product information into the protective means) and the substrate (the storage device).

In other words, it is only where there is a new and unobvious functional relationship between the printed matter and the substrate that the content of the printed matter is determined to be a structural limitation where the *particular* content of the indicia can be the basis of patentability.

In the determination of whether the printed matter is functionally related to the container, reference is made to the following two Federal Circuit decisions: *In re Gulack*, 703 F.2d. 1381 [217 USPQ 401] (Fed. Cir. 1983), and *In re Ngai* 70 USPQ 2d 1862 (CA FC 2004).

Quoting *Gulack*, "The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate." *Id.* at 1386. Accordingly, The CAFC determined that in *Gulack* there was a functional relationship between the printed matter

Art Unit: 3728

and the substrate as the printed matter and the substrate were functionally interrelated. Accordingly it was determined that there was a new and unobvious functional relationship between the substrate and the instructions.

To underscore this understanding, the CAFC stated within the *in re Ngai* decision "In *Gulack*, the printed matter would not achieve its educational purposes without the band, and the band without the printed matter would similarly be unable to produce the desired result." *Id.* at 1864.

In other words, the CAFC in *Gulack* sets forth what a new and unobvious functional relationship is with respect to this analysis, and this understanding was re-stated in *Ngai*.

In the present application, like the situation in *In re Ngai*, there is no new and unobvious functional relationship between the substrate (the storage device) and the printed matter (the product information in the protective means).

In *Ngai*, the court stated that "the printed matter in no way depends on the kit, and the kit does not depend on the printed matter." What was meant by this statement is that if the kit is suitable to perform its intended use without the printed matter, then there is no functional relationship as is understood in this analysis.

Similarly, in the present application, the storage device is suitable to perform the function of a storage device in the manner described in the specification irrespective of the specific product information in the protective means.

Accordingly, it is understood that a teaching of *any* indicia or information within the protective means of *Butcher* would suffice to reject these limitations. *Butcher* does

Art Unit: 3728

in fact suggest that the holograms are information bearing, and therefor meets this limitation.

Additionally, the claim limitation of "said protective means (the hologram) are designed such that specific product information is incorporated therein, specific for the data carrier to be stored in said storage device, so that an unequivocal relationship between the storage device and said data carrier is established" could be properly interpreted as the "intended use" of the information provided on the protective means.

For example, it is likely that the *intention* of the Visa credit card company that users of Visa credit cards will make an unequivocal relationship between 1) a protective device in the form of a hologram having a specific symbol (and eagle) that is disposed on Visa credit cards and 2) the Visa credit card company. However, regardless of this intent in the use of their credit card and the use of the protective device, the end user of the credit card may or may not make the association (the unequivocal relationship) that is intended by Visa. And in situations where the user does not comply with the *intent* of Visa in making this association (the unequivocal relationship), the Visa credit card (the "substrate" in the language of *In re Ngai*) will *still* function as it is intended as a credit card.

In the present application, the substrates (the storage device) will similarly perform its intended functions regardless of whether or not the end user makes an unequivocal relationship between the information in the hologram and information stored on the data carrier within the storage device. And, with respect to an interpretation of these claim limitations within the context of "intended use" limitations,

Art Unit: 3728

as is understood in the art, it is clear that whatever information Butcher intended be incorporated into his hologram, the information so incorporated into that hologram is inherently capable of being unequivocally related by the end user to the information on the data carrier.

Accordingly, these limitations do not define over Butcher.

Nevertheless, the *specific* information set forth in the protective device would need to be met to properly reject the claims, there exists in the prior art evidence to suggest that the broad concept of incorporating specific information into a hologram that is disposed on a product packaging and that is related unequivocally to the product disposed within the packaging is known.

Specifically, Wood discloses a protective means in the form of a hologram 7 that includes information "Jones" that is unequivocally related to the product stored in the packaging. Wood suggests that the motivation for relating the information in the hologram to the product is both for aesthetic reasons (col. 3, lines 42-47) and for security reasons (col.4, in particular line 8, but the whole column is relevant).

Accordingly, although not deemed necessary, from the teachings of Wood, it can reasonably be said that one of ordinary skill in the art would be motivated to incorporate product information into the hologram of Butcher that is unequivocally related to the informational content of the data carrier either for aesthetic reasons or for additional security.

Accordingly, Butcher, or to the extent necessary, Butcher in view of Wood, teaches the first protective means as is disclosed.

With respect to the limitations drawn to the second protective means, it is restated that on page 10, lines 37-31, Butcher describes how "an image can be embossed or raised out of the surface of the storage device through a single moulding operation." Butcher goes on to disclose, "Further, graphic images such as holograms can be added to the holder's surface. Hence information bearing holograms can be added for in-store tagging purposes."

Again, from this recitation, it can be inferred that Butcher contemplates *two* forms of information bearing images incorporated into the storage device, the first being an image that can be embossed or raised out of the surface of the holder, the second being a graphic image such as a hologram. Notice the use of the expression "Further." Butcher does not use the expression "Alternatively."

With respect to the content of the information of the second protective device, the same analysis as is set forth above with respect to the first protective device applies, and the limitations drawn to the second storage device are not deemed to define over Butcher.

However, to the extent necessary, Sammet discloses an image 18 of the type set forth in Butcher, and this image includes information that is specific to the data carrier to be carried in the storage device.

Accordingly, to the extent necessary, it would have been obvious to one of ordinary skill in the art to modify the storage device of Butcher to include specific information into the second storage device, as is suggested by Sammet, so that an

unequivocal relationship can be made between the second protective means of the storage device and a data carrier to be stored in the storage device.

Butcher does not disclose the first and second cover pivotally connected and the fixing means.

The Examiner takes Official Notice that this configuration of a storage device is the common configuration, and it would have been obvious to one of ordinary skill in the art to use the teachings of Butcher to the common configuration so as to maximize the commercial benefits of this concept. It is noted that Applicant did not contest this Official Notice.

To the extent necessary, Palmer et al. discloses the exact method step of forming a portion of a molded product against or around a protective means (hologram) in an injection molding step.

Accordingly, it would have been obvious to one of ordinary skill in the art to use the teachings of Palmer within the storage device of Butcher so as to minimize manufacturing steps.

Re the limitation in claim 20 drawn to the specific shape of the storage device, it is acknowledged that Butcher discloses a one piece storage device. However, one piece storage devices having first and second covers integral with each other are also well known. Again, the inventive concepts of Butcher are transferable to many known storage device configurations such as that of claims 1 and 20.

Re claims 21-28, 32 and 33, these claims set forth the known method steps of what is known in this art as in mold labeling which is commonly used to apply printing and other indicia to storage containers of all types. The Examiner takes Official Notice that the method steps disclosed in these claims are well known. This Official Notice was not contested by Applicant.

The following references provide extrinsic evidence of the Examiner's Official Notice: Kuramitsu et al. US 5,0825,435; Hanamoto et al. US 4,639,341; and Yamanaka US 5,254,302.

It would have been obvious to use this common technique to apply printing as the technique is well known, and as equipment for performing the technique are commercially available.

The Examiner believes that the specific subject matter set forth in claims 21-28, 33 and 24 was not likely intended to be set forth as an inventive concept representing the work of the Applicant. Instead, the Examiner believes that the subject matter set forth in these claims was known to be prior art subject matter incorporated into the broad invention set forth in claims 1 and 19. The Examiner's belief on this matter is informed by the fact that this complicated process is disclosed in a *single* paragraph in the specification. If this understanding is correct, please confirm this fact so that the examination of the inventive concept set forth in claim 19 is not diluted by an unnecessary effort being made to examine limitations within claims 21-28, 32 and 33, which the applicant considers to be prior art. It is noted that applications filed in class 206 often include numerous dependent claims drawn to known prior art subject matter,

Art Unit: 3728

and that examination of the inventive concepts within these applications is hindered by an absence of disclosure that the subject matter in certain dependent claims is known to be prior art. Additionally, it is also the Examiner's belief that the inventive concept set forth in claim 1 and 19 is not the particular process/structure of placing a protective means into a molded storage device broadly per se. Instead, the Examiner believes that the inventive concept is specifically that of the inclusion of product information into a protective device that has been integrally molded into a storage device, thus providing a protection against counterfeiting and theft that would not exist in the absence of this information. Please advise the Examiner on these understandings. If the Applicant believes that the specific structures/processes (absent the inclusion of product information) are known in the prior art, this would be helpful to the Examiner in determining patentability of the presented claims.

Election/Restrictions

This application contains claims drawn to an invention nonelected with traverse. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerrold Johnson whose telephone number is 571-272-7141. The examiner can normally be reached on 9:30 to 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3728

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JDJ



Mickey Y.
Supervisory Patent Examiner
Group 3750